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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/059,973 | 01/30/2002 | Shi-Chao Hong | 04621.1-P-5909 | 5871 |

7590 07/14/2003
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EXAMINER

FISCHMANN, BRYAN R

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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3618

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/059,973

Applicant(s)
HONG

Examiner
Bryan Fischmann

Art Unit
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 23, 2003
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-4 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on May 23, 2003 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 6) ☐ Other:

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Acknowledgments

1. The Substitute Specification (paper 5) and the Amendment (paper 6) filed 5-23-2003 have been entered.

Specification

2. The disclosure is objected to because of the following:

A) The substitute specification should begin with page number 1, not page number 13.

An amendment to renumber the pages is sufficient to overcome this objection. A new substitute specification is not required.

B) The recitation of "...one of commercial skate can be assembled with the general shoes...", as recited on the first page of the specification is considered awkward.

C) The reference to US Patent Application 09/737,955 on the first page is objected to as containing new matter.

Per Section 2163.06 of the MPEP, new matter in the specification should be objected to under 35 USC 132 or 251 and the Applicant is required to cancel the new matter unless he can cite specific support in the originally filed application for the "new matter".

Also, the description of newly added Figure 5 on page 2 is also considered new matter.

It is recommended that Applicant delete the reference to the above Patent Application and newly added Figure 5 to overcome this objection.

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Information Disclosure Statement

3. The Information Disclosure Statement - "IDS" (paper 7) listed Patent Application 09/737,955. Since this Application is now US Patent 6,547,261, the Examiner has instead considered this Patent which should contain the same drawing figures as the Application, and has modified the IDS accordingly.

If this is for some reason unacceptable to Applicant, request Applicant state so in the reply to this Office Action.

Drawings

4. Figure 5 is objected to, as the entire figure constitutes new matter.

To overcome this objection, recommend Applicant delete Figure 5.

Claim Objections

5. Claims 1-4 are objected to because of the following minor grammatical problems:

A) The word "and" should be present after the word "cover" on line 3 of claim 1.

B) The word "slide" should be plural on the fourth line of the fourth paragraph.

C) A period is missing at the end of claim 3.

D) In claim 1 line 4, the term "round" should be deleted for consistency/clarity.

80)
7/11/03

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Allowable Subject Matter

6. Claim 1 would be allowable if rewritten or amended to overcome the claim objection set forth in this Office action.
7. Claims 2-4 would be allowable if rewritten to overcome the claim objections set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Examiner's Comments

8. This Application is in a condition for allowance, except for the formal matters noted in this Office Action (paper 8). Note that even though the Applicant is just adding additional information on prior art (Gorza) to the Substitute Specification, this additional information is still considered new matter.
9. Since Applicant appears to be prosecuting the Application himself from overseas, and likely is not easily accessed by the Examiner by phone, the Applicant may want to consider authorizing the Examiner to make minor wording changes in the disclosure and claims in the reply to this Office Action. This way, in the event that the Examiner notices any additional minor problems that need to be corrected, the potential additional minor problems may be corrected without any additional correspondence.

Request Applicant give the specification and claims one more thorough review to assure all instances of awkward or grammatically incorrect wording has been corrected.

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Conclusion

10. This application is in condition for allowance except for the following formal matters:

- a) specification objections as set forth in this Office Action.
- b) the drawing objection as set forth in this Office Action.
- c) claim objections as set forth in this Office Action.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (703) 306-5955. The examiner can normally be reached on Monday through Friday from 7:30 to 4:00.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson, can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Application/Control Number: 10/059,973

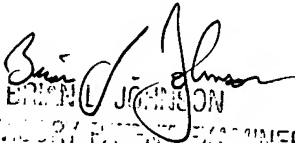
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

BF

07/09/03


BRIAN L. JOHNSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 8800
7/11/03